

Remarks/Arguments:

Claims 11-20, presented hereby, are pending.

Claims 1-10 are canceled, hereby, without prejudice or disclaimer.

Present independent claims 11 and 18 correspond to original independent claims 1 and 8, respectively. Present dependent claims 12-17 correspond to original dependent claims 2-7, amended to be dependent, directly or indirectly, on present claim 11. Present claims 19 and 20 correspond to original claims 9 and 10 respectively, rewritten as explained, below, in connection with the rejections of record under section 112, second paragraph, and section 101.

Claims 9 and 10 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite "use" claims, i.e., not setting forth any active method/process steps. Claims 9 and 10 were also rejected under 35 USC 101 for being allegedly non-statutory "use" claims. Reconsideration of the rejections under section 112, second paragraph, and section 101 is requested in view of the changes to the claims effected, hereby, taken together with the following remarks.

None of the present claims is a "use" claim. By the instant amendment, "use" claim 9 is rewritten, hereby, as dependent "object" claim 19, i.e., dependent on the independent "object" claim 18. Claim 10 is rewritten, hereby, as a dependent "object" claim, i.e., dependent on present claim 19. In that none of the present claims is a "use" claim, withdrawal of the rejections under section 112, second paragraph, and section 101 appears to be in order.

Claims 1-5 and 7-9 were rejected under 35 USC 102(b) as being allegedly anticipated by US 3,354,022 (Dettre). Claim 6 was rejected under 35 USC 103 as being allegedly unpatentable based on Dettre in view of US 4,183,757 (Groszek).

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

As allegedly meeting the claim limitation "a hydrophobic material which forms a self-cleaning surface by self-organization when the solvent is evaporated," the statement of rejection relies on allegedly "implied;" i.e., *inherent*, disclosure in the reference. The limitation is allegedly inherently disclosed "since they form [the] claimed arrangement of protrusions and recesses" (Office Action, page 3). The statement of rejection mistakenly relies on the theory of inherency in order to meet the claim limitation at issue.

For the doctrine of inherency to apply it must be "*inevitable*" from the teachings of the prior art. *In re Wilding*, 190 USPQ 59, 62 (CCPA 1976) (*emphasis added*). "In relying on a theory of

inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (*emphasis in original*). Before "the burden shifts," the examiner has "the initial burden of establishing a prima facie basis for the alleged inherency." 17 USPQ2d at 1463-64. To base a rejection on what is allegedly inherent in the reference teachings,

the examiner must . . . reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the applied prior art.

17 USPQ2d at 1464 (*emphasis in original*).

Assuming, arguendo, that the presently recited "self-organization" might occur in one or more embodiments of the Dettre invention, which applicants do not concede, the limitation is not *inherently* disclosed in the reference because it is not an *inevitable* result of the Dettre invention. Dettre expressly teaches the need for "embossing dies" in order to effect the surface protrusions "high portions". Dettre, Example 1 (col. 9, line 40-col. 10, line 26) uses "an embossing die" to produce an "embossed surface [that] consists of an array of cylindrical projections oriented at right angles to the original wax surface" (Dettre col. 9, lines 50 and 57-59). Dettre, Examples 2-4 and 6 also use the die-embossing method of Dettre Example 1 in order to produce the desired surface protrusions.

Whether the "self-organization" feature of the present claims might be "implied" by one or more embodiments in Dettre, the "self-organization" feature is not an *inevitable* result of Dettre;

since Dettre expressly teaches the need for die-embossing in order to produce the desired surface protrusions, the "self-organization" feature is not the only, i.e., *inevitable* result of Dettre. As such, a limitation on the present claims being absent from Dettre, anticipation is negated. *Kolster Speedsteel AB, supra*, and withdrawal of the section 102(b) rejection based on Dettre appears to be in order.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). A "ground of rejection is simply inadequate on its face . . . [when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982).

The section 103(a) rejection of claim 6 (corresponding to present claim 16) falls for the same reasons set forth, above, in connection with the rejection under section 102(b). The secondary reference, Groszek, adds nothing to cure the fatal deficiency of the primary, Dettre reference.

In order to rely on the theory of inherency to support a rejection under section 103(a), the allegedly inherent teaching must be an *inevitable* result of the prior art teachings relied on to reject

the claims. An argument by the PTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). When the

PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears *in the reference*. ... The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to establish inherency. ... [S]uch a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.

28 USPQ2d at 1557 (*emphasis added*). A "retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination." *In re Newell*, 13 USPQ 2d 1248, 1250 (Fed. Cir. 1989).

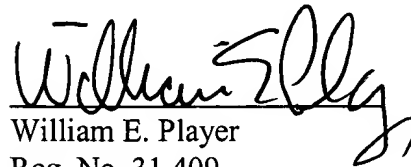
Accordingly, inherency of the "self-organization" feature of rejected claim 6 (and present claim 16) not being an *inevitable* result of the combined prior art teachings, the claim feature at issue is not *inherently* disclosed in the combined prior art teachings. *Newell*. Since "the cited references do not support each limitation of [the] claim," the rejection under section 103(a) is "inadequate on its face," *Thrift*, 63 USPQ2d at 2008, and withdrawal of the rejection appears to be in order.

Favorable action is requested.

Respectfully submitted,

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